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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,001	09/22/2003	Philip Martin McGenity	HO-P02110US2	1938
26271	7590	04/07/2004	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			SAYALA, CHHAYA D	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,001

Applicant(s)

MCGENITY ET AL.

Examiner

C. SAYALA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Specification

1. Applicant's reference to prior applications needs correction: The filing date of application Serial No. 10/283,788 should Oct. 30, 2002 and not Oct 29th.

Also, all this application should be updated with its Patent No. 6,652,892.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These two claims depend from claim 30 and this dependency appears to be incorrect based on the limitations of claim 30. Correction is required to render these claims definite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Richar (US Patent 5405836).

Richar teaches chlorophyll extracts in biscuits for dogs to diminish dog breath malodor. See col. 14, lines 15-0; col. 15, lines 35-40; Table IV. The patent teaches 8 mg chlorophyll, which is typically extracted from plants.

4. Claims 21-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Paluch (US Patent 6117477).

At col. 7, lines 45-53 and col. 8, lines 25-31, Paluch teaches adding breath-freshening ingredients to a dough-containing pet food and baking the whole. Amounts and sizes are dependent on the size of the pet.

5. Claims 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Baasiouny et al. (Food Chem., vol. 37(4), p. 297-305, 1990).

The reference teaches a dough composition and plant extracts in the amounts claimed. Note that the extracts are known in the art to freshen breath, and the terms "pet food" in the preamble have been given little weight because it is known in the art that pet foods use dough to make them and that a compound and its properties cannot be separated.

6. Claims 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuller (US Patent 4294857).

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The patent teaches the addition of linalool, which is a plant extract, to a dough, to make pet foods. See the amounts taught. Linalool is used as a palatability enhancer, although it is well known that extracts that contain linalool freshen breath (See PTO-892). Col. 2, lines 35-39, col. 3, lines 45+ and col. 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aga et al. (US Patent 5922324) in view of the specification at page 2, lines 8-10.

Aga et al. teaches adding a particular breath-freshening agent, propolis extract, as those claimed herein to pet foods as oral-refreshing agents. Amounts for adults are shown, however, it would have been obvious to use appropriate amounts for dogs depending on the composition intended as well as the size of the dog. See col. 5, lines 5-10, 14 and 50-53. The specification teaches that the addition of breath-freshening active ingredients to pet foods is known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such an extract in pet foods. It is known in the art that pet foods are generally made from dough

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compositions, and Example B-5 shows that the extract can be incorporated in dough compositions and baked. Note the amounts used.

8. Claims 21-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaglione et al. (US Patent 5000973) in view of CFR, Title 21, Part 101, Subpart B, Sec. 101.22 and further in view of Nabi et al. (US Patent 5472684).

Scaglione et al. teach a dough composition that contains natural flavors intended for a dog. See Tables 2 and 4. The composition is nutritionally balanced and contains a tartar preventing agent. The natural flavors are not disclosed as being breath freshening. CFR Title 21 defines what is meant by "natural flavors", which includes essential oils and plant extracts, fruit juices, oleoresins, etc. Nabi et al. teach a composition that contains tea tree oil, and eucalyptus, in the same ranges as claimed herein, and further disclose that such flavoring agents enhance antiplaque and antigingivitis activity. For this reason, it would have been obvious to one of ordinary skill in the art to add such agents to the Scaglione composition that calls for natural flavorants with the reasonable expectation that it would aid in antiplaque and antigingivitis activity, where the Scaglione invention is drawn to reduce or prevent tartar accumulation (see col. 1, lines 1-20 in '973).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 21-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6495176. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in scope only, and include all of the limitations of the instant claims.

10. Claims 21-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6652892. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ in scope only, and include all of the limitations of the instant claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. SAYALA
Primary Examiner
Group 1700.